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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte PAUL NIELSEN

_____

Appeal 2008-004422
Application 09/966,026
Technology Center 1700

_____

Decided:[1] June 29, 2009

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Before, MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

FISCHETTI, *Administrative Patent Judge.*

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as
recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this
page of the decision. The time period does not run from the Mail Date (paper
delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-29. We have jurisdiction under 35 U.S.C. § 6(b). (2002).

SUMMARY OF DECISION

We AFFIRM IN PART.

THE INVENTION

Appellant claims a system and method for analyzing a self-service network, selecting advertisements for self-service terminals, to a data warehouse and to a self-service terminal. (Spec. 1:4-5).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method of selecting advertisements for display on and/or adjacent to a plurality of self- service terminals comprising the steps of:
(a) collecting environment data related to the environment of each terminal including the nature of businesses nearby the terminal;
(b) collecting transaction data indicating the type and time of transactions carried out at the terminal; and
(c) storing the collected data in a data warehouse.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

De Leo   US 6,381,626 B1   Apr. 30, 2002

"For Banks, ATM advertising could be right on the money." Mark Calvey, San Francisco Business Times, July 19, 1996.

The following rejections are before us for review.

The Examiner rejected claims 1, 2, 4, 7 - 9, 11, 14 - 17, 19 - 22, and 24 - 29 under 35 U.S.C. § 102, based on De Leo.

The Examiner rejected claims 3, 5, 6, 10, 12, 13, 18, and 23 under 35 U.S.C. § 103, based on De Leo and Calvey.

ISSUES

Has Appellant shown that the Examiner erred in rejecting claims 1, 2, 4, 7 - 9, 11, 14 - 17, 19 - 22, and 24 -29 on appeal as being unpatentable under 35 U.S.C. § 102(e) on the grounds that a person with ordinary skill in the art would understand that the disclosure in De Leo of "an advertisement for a local fast food establishment" generated by a nearby ATM would be the result of collecting environment data related to the environment of that terminal including the nature of businesses nearby the terminal?

Has Appellant shown that the Examiner erred in rejecting claims 1, 2, 4, 7 - 9, 11, 14 - 17, 19 - 22, and 24 -29 on appeal as being unpatentable under 35 U.S.C. § 102 (e) on the grounds that a person with ordinary skill in the art would understand that the disclosure in De Leo of using the configuration files to generate messages based on transaction data to generate targeted messages at an ATM using net worth information of users' account data means that it is inherent that the system in De Leo must have first collected data related to the transaction history of the transaction data to effect the time targeted message?

Has Appellant shown that the Examiner erred in rejecting claims 3, 5, 6, 10, 12, 13, 18, and 23 on appeal as being unpatentable under 35 U.S.C. § 103(a) over

on the grounds that a person with ordinary skill in the art would understand that De Leo could be modified to include the advertisement effectiveness measurement feature of Calvey to better target advertisements to its users?

PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.").

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. The Examiner found that the De Leo et al. reference is directed to location based targeted advertising which requires knowledge of the location of the terminal and the nearby business in that

> "… De Leo et al. teach the feature of displaying a
> promotion for a fast food restaurant at during lunch hours
> and a motion pictures during the evening hours - see col
> 5, lines 26-36 (there would be no point in displaying a
> promotion to a restaurant that is not nearby or a movie
> that is not shown at a nearby movie theater during a
> specific time window of a few hours). (Ans. 13).

2. De Leo discloses "… a message file promoting a fast-food restaurant may be displayed during the period 11 AM to 2 PM to promote lunch trade, while a message file promoting a motion picture may be selected in the period 4 PM to 8 PM. (De Leo, col. 5, ll. 26-30).

3. The Examiner further found that "[t]he localized feature is further taught as De Leo et al. recites that "an advertisement for a local fast food establishment can have an associated coupon for a daily meal discount" (col. 6, ll. 53-55)." (Ans. 13).

4. De Leo discloses that

> …commercial message delivery can be specific and
> delivered to a user who is paying attention to the monitor.
> The display of messages to the user is recorded by the
> ATM 18 in the form of a detailed "play log." The play
> log can include detailed reporting regarding each non-
> transaction message including the time, location,

> customer demographics, and other such information
> related to the display of the message. The play log data
> can be provided to the message processor 28 for purposes
> of reporting and billing to a sponsor of the message.
> Such a detailed reporting log is useful to the sponsor in
> judging the performance of the non-transaction messages.
> (De Leo, col. 8, ll. 32-42).

5. The Examiner found De Leo discloses two types of data, 1. the type which drives advertisements, such as, "an advertisement for a local fast food establishment can have an associated coupon for a daily meal discount" (FF 3), and 2. transactional data. (Answer 13,14)

6. De Leo defines

> Transaction data, as used herein, refers to digital data
> relating to the primary transaction requested by the user.
> Typical transaction data would include data read from the
> banking card, debit card or credit card of a terminal user;
> data entered by a user, such as e PIN number, transaction
> type, transaction amount, etc. and data sent by the host 12
> relating to the transaction, such as requests for further
> information regarding selection of an account, regarding
> a usage fee, transaction approvals or transaction denial
> messages and responses to such requests. (De Leo, col. 3,
> ll. 66- col. 4, l. 7).

7. The Examiner found that "…De Leo et al. teach the feature of database storage by the host system (col. 4, ll. 53-60) and collection of data such as "message files, configuration files and transaction data" (col. 8, ll. 44-45) and "play-log" to be used for accounting purposes (col. 8, ll. 39-43)." (Ans. 13).

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8. De Leo discloses collecting of transaction data in that this data is both organized in router 24 and sent to terminals 18 preferably by satellite transmitter/receiver 30 (De Leo, col. 8, ll. 63-67).

9. De Leo further discloses using the configuration files to generate messages based on transaction data. (De Leo, col. 5, ll. 43-45).

10. The transaction based messaging in De Leo causes a selection to be made "…on the basis of data known to the host or issuer such as account balance. Accordingly, the host or issuer can identify the terminal user as high net worth individual and provide a demographically targeted non-transaction message promoting luxury automobiles…." (De Leo, col. 5, ll. 46-66)

11. The Examiner found that De Leo discloses collecting advertising data which describes the type and content of one or more advertisements displayed:

> …De Leo et al. teach a targeted advertising system which includes various parameters such as "time, location, customer demographics" that are collected via a "play-log" which are then used in the "billing a sponsor of the message" (see col 8, lines 29-43) thus a history of advertisement displayed is created in order to bill the proper sponsors. Furthermore, De Leo et al. teach the features of cycling the advertisements to specific times and locations (col 5, lines 53-55) and updated configuration files (col 6, lines 7-23) which are based on a history of advertising data being collected. (Ans. 14).

12. The Examiner found that De Leo discloses at least near real time collecting and storing in that:

> De Leo et al. teaches the use of advertising targeted to specific transactions; thus, the collection of data is

deemed to be in "real- time" since the data regarding the occurring transaction has to be collected in order to select the targeted advertising to be shown in course of the customer's interaction with the ATM (col 5, lines 44 to col 6, line 7). (Ans. 15).

13. The Examiner further found that the claim language is "in real time or near real time" in line 2 (emphasis added by the Examiner) with "near real time" being defined in the Specification as "possibly with a lag of a few hours" (p. 2, ll. 20-22). (Ans. 15.)

14. The Examiner found with regard to claim 29 that Leo et al. teach a targeted advertising system which includes various parameters such as "time, location, customer demographics" that are collected via a "play-log" (see col 8, lines 29-43). Thus the collected data are queried during the advertising selection process to a data warehouse. De Leo et al. teach the feature of database storage by the host system (col 4, line 53-60) and collection of data such as "message files, configuration files and transaction data" (col 8, lines 44-45) and "play-log" to be used for accounting purposes (col 8, lines 39-43). The features of showing specific advertisements to specific times and locations, updated configuration files and selection of a transaction-based advertisement are commensurate with the data warehouse functions defined by Appellants. (Ans. 16-17).

15. Calvey discloses that

[i]t's become a common practice for smaller companies to establish relationships with banks to advertise in some form with ATMs," said Carolyn Bretschneider, a spokeswoman for Visa International in Foster City. Visa owns the Visa/Plus ATM network, but the 280,000

> machines in the network are owned by the banks.
> BankAmerica is touting Lucky's daily specials at ATMs
> located inside the supermarket. The Lucky promotions
> are found on-screen and on receipts. (Cavley, p. 1 ¶¶3,4)

16. The Examiner found that De Leo teaches an implementation of the targeted advertising system on various networks (col 5, lines 1-7). (Ans. 24).

17. The Examiner found that Calvey teaches that it is known to determine the effectiveness of displaying advertising material (Ans. 10), in that

> "ATM advertising is location specific. If a fast-
> food restaurant is not within site distance or at most one
> or two miles, it won't be effective," he said.
>   A Subway restaurant, which notes on its ATM
> coupon that it's located two doors down from the
> machine, gets a response rate of 10 percent to 15 percent,
> Pidgeon said. On average, the bank's ATM coupons have
> a 4 percent to 8 percent response rate. (Calvey, p. 2,
> ¶¶8,9)

18. The Examiner found with respect to claim 13 that

> De Leo et al. teaches the variables of the frequency
> of the display of an advertisement, the content of the
> advertisement and the timing during the day (col 5, lines
> 19 - 43). In an analogous art, Calvey teaches that it is
> known to determine the effectiveness of displaying
> advertising material as set forth in page 1, § 8 and 9 to
> better estimate the efficiency of the advertisement shown.
> Therefore, it would have been obvious to one having
> ordinary skill in the art at the time the invention was
> made to modify the method as taught by De Leo et al.,
> with measuring the effectiveness of displaying
> advertisements as taught by Calvey. (Ans. 11).

ANALYSIS

We sustain the rejections of claims 1-6, 9-13, 16-18, 21-23, 26-29 and do not sustain the rejection of claims 7, 8, 14, 15, 19, 20, 24 and 25.

The Rejection of Claims 1, 2, 4, 7 - 9, 11, 14 - 17, 19 - 22, and 24 - 29 under 35 U.S.C. § 102

Claims 1, 9 and 22

Appellant argues claim 1 as representative which recites in pertinent part:

(a) collecting environment data related to the environment of each terminal including the nature of businesses nearby the terminal.

The Examiner found that De Leo is directed to location based targeted advertising which requires knowledge of the location of the terminal and the nearby business because "there would be no point in displaying a promotion to a restaurant that is not nearby or a movie that is not shown at a nearby movie theater during a specific time window of a few hours." (FF 1).

Appellant however maintains that although the collecting feature may be implicit in De Leo, the Examiner "...Answer's assertion is highly dubious, because advertising is done for many different reasons." (Reply Br. 4). We disagree with Appellant. Stating that different reasons may exist for why a local advertisement is being shown does not prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best,* 562 F.2d 1252, 1255 (CCPA 1977). The fact that another reason might exist for presenting "an advertisement for a local fast food establishment" does not diminish the fact that the ATM advertisement targeted a *local* establishment over the universe of other establishments thus functioning like that of Appellant's. We thus find that in

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order for the De Leo ATM to present an advertisement, such as, a local fast food establishment to a user, it must have first collected environment data related to the environment of the involved terminal including the nature of businesses nearby i.e., the local fast food establishment. "[I]f the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002) (citations and internal quotation marks omitted).

Appellant contends that "… the latter type of data (that describing nearby businesses) [which the Examiner asserts] is present in De Leo in the advertisements which the terminals display…. creates a problem in dependent claims, which state that the "data" is used to select advertising." (Reply Br. 4-5). We disagree with Appellant because the Examiner found that there are two distinct types of data which are disclosed by De Leo, namely, 1. a type which drives advertisements, such as, an advertisement for a local fast food establishment can have an associated coupon for a daily meal discount, and 2. transactional data. (FF 5, 6). Thus, we do not find error in the Examiner's interpretation of De Leo and the rejection of claims 1 and 22.

Claims 2 and 17

Claim 2 recites in pertinent part:

 (d) collecting advertising data which describes the type and content of one or more advertisement displayed on or adjacent to the terminal at particular times.

The Examiner found that De Leo discloses this limitation in his disclosure of the play log. (FF 7). Appellant however argues that 1. the play log "… does not

correspond to the "transactions" recited in the claim, which clearly refer to a customer's ATM transactions and 2. "...claim 2, in effect, states that a history of the type of advertising previously displayed is created." (App. Br. 23, 24). We disagree with Appellant because 1. nowhere in claim 2 is the collected information tied to transaction data, and 2. the play log is disclosed as a log of advertising and by virtue of the message itself being stored, not to mention the other descriptive attributes of data which are also stored, such as, customer demographics (FF 4, 7), it includes data containing type and content of one or more advertisement displayed on or adjacent to the terminal at particular times.

Appellant asserts that "claim 17, in effect, recites creating a history of advertising displayed at the terminal."(App. Br. 34). However, the Appellant's arguments "fail from the outset because . . . they are not based on limitations appearing in the claims . . .," and are not commensurate with the broader scope of claim 17 which merely recites holding advertising data. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Claims 4, 11, and 16

Claim 4 recites in pertinent part wherein the data is collected and stored in real time or near real time.

The Examiner found that the term "real time" means "possibly with a lag of a few hours." (FF 13). We find that De Leo discloses recording the display of messages by the ATM 18 in the form of a detailed "play log" such that the play log data can be provided to the message processor 28 for purposes of reporting and billing to a sponsor of the message (FF 13). We find that such a recording process

reasonably would need to be accomplished at least within a few hours of the transaction because the buffering requirements for such un-stored data would be too great to handle in an ATM device.

Appellant likewise argues that claim 16 distinguishes from De Leo because De Leo states that the "configuration file" is updated, and a time delay occurs before a new "configuration file" becomes active and thus "configuration files" are sent out on a "periodic basis." (Ans. 34). We disagree with Appellant. Claim 16 alternatively recites "or real time" which the Specification describes as meaning "possibly with a lag of a few hours." We find it reasonable to interpret De Leo as periodically updating the configuration file at least every two hours given that the device involves banking which is already is based on instantaneous reporting of account transaction data.

Claims 7, 14, 19 and 24

Representative claim 7 recites in pertinent part (e) querying the data warehouse to determine which terminals are located on sites at which a selected business activity is carried out; and (f) selecting an advertisement for display which includes content related to that business activity.

The Examiner maintains that since De Leo teaches the feature of database storage by the host system, and collection of data such as "message files, configuration files and transaction data" and "play-log" used for accounting purposes, these features "are commensurate with the data warehouse functions defined by Appellants." (Ans. 16-17).

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However, De Leo fails to explicitly disclose querying the data warehouse to determine which terminals are located on sites at which a selected business activity is carried out, and the Examiner's explanation falls short of such. That is, the claim requires something different from the Examiner's articulate reasoning of "there would be no point in displaying a promotion to a restaurant that is not nearby or a movie that is not shown at a nearby movie theater during a specific time window of a few hours." (FF 1). This is because the claim requires that the business activity is used as the metric for the search, rather than using the location of the ATM for the search as the Examiner's logic suggests, we cannot sustain the rejection of claims 7, 14, 19 and 24 under 35 U.S.C. § 35 U.S.C. § 102 (b).

Claims 8, 15, 20, 25

Claim 8 recites (e) querying the data warehouse to calculate a statistical distribution of the frequency of different transactions occurring at a terminal; and (f) selecting an advertisement for display at the terminal dependent on the statistical distribution.

> The Examiner maintains that because
>> De Leo teaches showing advertisement depending on the
>> current transaction and requirement of the sponsors, a
>> statistical distribution is implied since a frequency
>> parameter is needed. Furthermore, a reasonable
>> interpretation of a statistical distribution includes a range
>> value of 0 to 1 thus the selection of the ad based on the
>> type of transaction (thus having a value of 1) is construed
>> as meeting the claim limitation. (Ans. 17).

We do not agree with the Examiner because it is not apparent from De Leo that the ATM uses a range of 0 to 1 and necessarily functions in accordance with,

or includes, the claimed limitation of calculating a statistical distribution of the frequency of different transactions occurring at a terminal; and (f) selecting an advertisement for display at the terminal dependent on the statistical distribution. *In re Cruciferous Sprout Litig.,* 301 F.3d 1343, 1349 (Fed. Cir. 2002). We therefore cannot affirm the rejection of claims 8, 15, 20 and 25.

Claims 21, 26, 27 and 28

Claim 21 recites in pertinent part, means for determining which transactions occur at one or more terminal within a predetermined time period of a public event or a sporting event.

Appellant seeks an explicit disclosure in De Leo of "-- the claimed "transactions" which are determined (i.e., identified); -- the claimed "predetermined time;" and -- the "event." (App. Br. 35).

As found supra, De Leo discloses "... a message file promoting a fast-food restaurant may be displayed during the period 11 AM to 2 PM to promote lunch trade, while a message file promoting a motion picture may be selected in the period 4 PM to 8 PM. (FF 2). De Leo further discloses using the configuration files to generate messages based on transaction data. Since, De Leo discloses targeting predetermined time periods, 11AM-2PM/4PM-8PM, of public events, restaurants/movies, and generating messages based on the transaction data, it is inherent that the system in De Leo must have first collected data related to the transaction history of the transaction data to effect the time targeted message. "[I]f the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates." *In re Cruciferous Sprout Litig.,* 301 F.3d 1343, 1349

(Fed. Cir. 2002) (citations and internal quotation marks omitted).

Claim 27 recites in pertinent part, means for sending information to the network which identifies which transactions are occurring at the terminal and at what time they occur. For the reasons set forth above regarding claim 21 we affirm the rejection of claim 27. Appellant further argues that because in De Leo the host already knows what transactions are occurring at the ATM, "[c]onsequently, there is no reason for the ATM to transmit the claimed 'information' to the host." (App. Br. 37, 38). We disagree with Appellant. Appellant's admission that the host has knowledge of the on-goings of the ATM because it controls it, by definition means that the data is somehow accounted for by the host, e.g., sent to it from the ATM, because these are two separate devices (FF 8).

Claims 26 and 28 are argued against by Appellant for the same reasons as forth for claims 21 and 27, respectively, and hence we sustain the rejection of these claims for like reasons.

Claim 29

Appellant argues that a prima facie case has not been established because the Examiner has not identified where De Leo discloses "--the claimed "database;" -- the claimed data, stored in the database, about "transactions" and the "advertising" displayed with those "transactions;" and --the claimed "querying." (Ans. 39).

While the Examiner has not set forth an accounting of elements in an easy to recognize format, we nevertheless find that a proper finding of the requested

elements was made by the Examiner. Specifically, the Examiner found that De

Leo discloses a host system database or data warehouse[2] which stores the

messages sent to the ATMs (FF 4, 14). The Examiner further found that the

system also uses a play log having parameters such as "time, location, customer

demographics" which collects/stores information on the messages played (FF 4,

14). As found *supra* in our analysis of claim 21, we found that the host system

inherently stores transactional data in order to use the configuration files to

generate messages based on transaction data (FF 9). We further find that

generating such transaction based data messaging must inherently be based on

some analysis of the host system database involving a query, e.g., money in a

given account is queried and a corresponding message on a car commensurate with

the account balance is sent (FF 10). We thus affirm the rejection of claim 29.

*Claims 3, 5, 6, 10, 12, 13, 18, and 23 rejected under 35 U.S.C. § 103, based
on De Leo and Calvey.*

Claims 3 and 10

Claim 3 recites in pertinent part wherein the plurality of terminals are

distributed across more than one deployer network. Appellant argues that claim 3

requires that the terminals in both networks perform those actions of claim 1. (App.

Br. 40). Assuming this interpretation to be correct, there is still no argument by

Appellant that the proposed combination prohibits this from happening. Rather,

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[2] The Examiner also found that the Specification only broadly uses the term "data
warehouse" to broadly refer to a storage means which is able to store data in such a
manner that it is easily and quickly accessible in real time. (Ans. 16).

Appellant is attacking the Calvey reference individually when the rejection is based on a combination of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Young*, 403 F.2d 754, 757-58 (CCPA 1968). The Examiner has properly articulated a basis for making the combination finding that De Leo teaches an implementation of the targeted advertising system on various networks (FF 16). This would reasonably support the Examiner's analysis that more diverse groups of users, such as those who use VISA®, or Bank of America®, could have access to the De Leo system. Hence, we are not persuaded of error in the Examiner's prima facie case.

Appellant next argues that claim 1 recites a "single 'data warehouse.'" (App. Br. 41). However, the Appellant's arguments "fail from the outset because . . . they are not based on limitations appearing in the claims . . .," and are not commensurate with the broader scope of claim 1 which only uses the indefinite article *a* data warehouse and not the word single. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Appellant also argues that "[n]o valid teaching has been given in favor of combining the references." (App. Br. 41). However, the Examiner has properly articulated a basis for making the combination finding that De Leo teaches an implementation of the targeted advertising system on various networks (FF 16). We consider the disclosure of a system useable with various networks to be reasonable support for broadening markets, and hence we are not persuaded of error in the Examiner's prima facie case.

Even still, to the extent Appellants seek an explicit suggestion or motivation in the reference itself, this is no longer the law in view of the Supreme Court's recent holding in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

Appellant re-asserts the arguments used for claim 3 in support of claim 10, the rejection for which we do not sustain, and thus do not sustain the rejection of claim 10.

Claim 5

Claim 5 recites in pertinent part, e) querying the data warehouse to determine the relationship between the effectiveness of an advertisement and the terminal on or adjacent which it is displayed.

Appellant argues that the Office Action "...has not shown the particular method claimed in making the assessment (ie, storing data from terminals in a data warehouse, and querying the warehouse.)" (App. Br. 46). We disagree with Appellant.

As found *supra*, with respect to claims 4 and 21, De Leo discloses both storing data from terminals in a data warehouse, and querying the warehouse. With respect to the recited goal of determining the effectiveness of an advertisement, we find that De Leo discloses causing a message selection to be made "...on the basis of data known to the host or issuer such as account balance to provide a demographically targeted non-transaction message such as promoting luxury automobiles." (FF 10). As such, we find that De Leo discloses an effectiveness determination in that it only matches accounts which would be effective in purchasing an item of comparable value.

Appellant next argues that "…there is nothing present in the claimed 'data warehouse,' supposedly found in the references, which tells how many people used the coupons." (App. Br. 47). We disagree with Appellant because Appellant's arguments are not based on limitations appearing in the claims . . .," and are not commensurate with the broader scope of claim 5 which merely recites querying the data warehouse to determine the relationship between the effectiveness of an advertisement and recites nothing about any coupon redemption. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

In light of the breadth of the claim, the Appellant's argument is not persuasive as to error in the rejection.

Claims 6, 18 and 23

Claim 6 recites in pertinent part wherein the effectiveness of an advertisement is measured by determining how often the display of an advertisement on or adjacent a terminal is substantially coincident with a transaction which is related to the advertising content, being initiated by a user at that terminal. The Examiner found that Calvey teaches that it is known to determine the effectiveness of displaying advertising material because Calvey discloses that ATM advertising is location specific and "[i]f a fast-food restaurant is not within site distance or at most one or two miles, it won't be effective…." (FF 17). Furthermore, the we find that Calvey discloses measuring effectiveness in that a SUBWAY® that is located two doors down from an ATM gets a response rate of 10 percent to 15 percent form its ATM delivered coupons whereas, on

average, the bank's ATM coupons have a 4 percent to 8 percent response rate. (FF 17).

Appellant argues however that the recited "coincident" refers to nearness of time and not spatial nearness. (App. Br. 48). We disagree with Appellant because Appellant's arguments is not based on limitations appearing in the claims because the broader scope of claim 6 which merely recites substantially coincident which would include spatial coincidence. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

In light of the breadth of claim 6, the Appellant's argument is not persuasive as to error in the rejection.

Appellant re-asserts the arguments used for 6 in support of claims 13, 18, and 23, which we found unpersuasive.

Claim 12

Claim 12 recites in pertinent part (d) querying the data warehouse to determine the relationship between the effectiveness of an advertisement and the terminal on or adjacent which it is displayed. Appellant argues that has not been shown in the references. (App. Br. 50). We disagree with Appellant. As discussed above with respect to claim 5, De Leo discloses querying the accounts database to establish an effectiveness relationship between transaction data and a message (FF 10). Calvey discloses analyzing an ATM location with reference to a local business e.g., a SUBWAY® store. A person with ordinary skill in the art would thus know to query the host database in De Leo to determine a relationship between a restaurant location and that of a terminal. We therefore conclude Appellant has failed to show error in the Examiner's prima facie case.

Claim 13

Claim 13 recites in pertinent part the effectiveness of an advertisement is measured by determining how often the display of an advertisement on or adjacent a terminal is substantially coincident with a transaction which is related to the advertising content, being initiated by a user at that terminal.

Appellant asserts that claim 13 requires coincidence between (i) display of advertising and (2) a transaction relating to the advertising and this has not been shown. We disagree with Appellant. The Examiner found with respect to claim 13 that the combined teachings of De Leo and Calvey result in the features of claim 13 (FF 18). It is not apparent, and Appellant has not cogently explained, why this combination fails to show the enumerated features of claim 13 except for a general assertion to the contrary. We thus conclude Appellant has failed to show error in the Examiner's prima facie case of the rejection of claim 13.

CONCLUSIONS OF LAW

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 1, 2, 4, 9, 11, 16, 17, 21, 22, 26, 27, 28 and 29 under 35 U.S.C. § 102, based on De Leo and has shown that the Examiner erred in rejecting claims 7, 8, 14, 15, 19, 20, 24 and 25 under the same rejection.

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 3, 5, 6, 10, 12, 13, 18, and 23 under 35 U.S.C. § 103, based on De Leo and Calvey.

DECISION

The decision of the Examiner to reject claims 1-6, 9-13, 16-18, 21-23, 26-29

is AFFIRMED.

The decision of the Examiner to reject claims 7, 8, 14, 15, 19, 20, 24 and 25

is REVERSED.

AFFIRMED-IN-PART

JRG

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